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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/041,981 | 01/09/2002 | Christopher J. Riddick | 86.1002 | 5767 |

7590 07/21/2005
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EXAMINER

TO, BAO TRAN N

ART UNIT PAPER NUMBER

2135

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,981

Applicant(s)

RIDDICK ET AL.

Examiner

Bao Tran N. To

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/24/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-24 are pending in this application.

Drawings

2. The drawings are objected to because figures 1-3, 5-7, and 11 are informal drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-20 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Spies et al. (U.S. Patent 6,055,314) herein referred to as Spies.

Regarding on Claim 1, Spies discloses a system for reading data from a protected media item, comprising:

a smart token (IC card) carried by a user(viewer) and containing a decryption key (decryption capabilities) linked to a specific decryption device (col. 2, lines 30-35);

a hardware decryption module (viewer computing unit) connectable to said smart token and functioning as a decryption device when the decryption key is linked to said hardware decryption module (Fig. 3, element 60, col. 9, lines 5-15); and

a host device (set top box "STB") connectable to said hardware decryption module so that said hardware decryption module serves as a decryption device for said host device when the decryption key is linked to said hardware decryption module (col. 3, lines 10-20).

Regarding on Claim 2, Spies discloses the limitations as discussed in Claim 1 above. Spies further discloses wherein said hardware decryption module reads the

decryption key from the smart token when said smart token is connected to said hardware decryption module (col. 9, lines 13-17),

determines whether the decryption key is linked to the hardware decryption module, and decrypts data from the protected media item prior to providing it to said host device when it is determined that the decryption key is linked to the hardware decryption module (col. 9, lines 15-20).

Regarding on Claims 3 and 13, Spies discloses the limitations as discussed in Claim 2 above, Spies further discloses wherein said hardware decryption module comprises an external interface connected between said smart token and said host device (Fig. 7, element 160, col. 12, lines 55-60).

Regarding on Claims 4, 7, 14 and 16, Spies discloses the limitations as discussed in Claim 3 above. Spies further discloses wherein said hardware decryption module further comprises a control processor connected to said external interface for controlling operation of said hardware decryption module (Fig. 7, col. 12, lines 45-47).

Regarding on Claims 5, 8, 15 and 17-18, Spies discloses the limitations as discussed in Claim 4 above, wherein said hardware decryption module further comprises a decryption processor (decryption unit) connected to said control processor for decrypting the data from the protected media item prior to providing it to said host device (Fig. 8, col.13, lines 35-40).

Regarding on Claims 6, 9 and 11-12, Spies discloses the limitations as discussed in Claim 5 above, Spies further discloses wherein said hardware decryption module further comprises a memory for storing decryption key information for comparison with the decryption key from the smart token so as to determine whether the decryption key is linked to the hardware decryption module (col. 12, lines 45-50).

Regarding on Claim 10, Spies discloses the limitations as discussed in Claim 2 above, Spies further discloses wherein said hardware decryption module comprises a decryption processor for decrypting the data from the protected media item prior to providing it to said host device (col. 13, lines 35-40).

Regarding on Claim 19, Spies discloses the limitations as discussed in Claim 1 above, Spies further discloses wherein said hardware decryption module comprises a case having a surface in which a plug is formed for connection to said host device, said case having a socket formed therein for receiving the smart token (col. 9, lines 5-20).

Regarding on Claim 20, Spies discloses the limitations as discussed in Claim 1 above, Spies further discloses wherein said hardware decryption module comprises a case, a plug for connection to said host device, and a cable interconnecting said case and said plug, said case having a socket formed therein for receiving the smart token (col. 9, lines 5-20).

Regarding on Claim 22, Spies discloses the limitations as discussed in Claim 1 above, Spies further discloses wherein said host device sends to said hardware decryption module at least one of an initialize decrypt command, a decrypt data block command, a make copy command, and a retrieve player digital identifier (PDI) command (col. 2, lines 36-42).

Regarding on Claim 23, Spies discloses the limitations as discussed in Claim 1 above, Spies further discloses wherein said hardware decryption module sends to said host device at least one of returned decrypted data, a returned encrypted record, and a returned hardware decryption module player digital identifier (col. 10, lines 48-56).

Regarding on Claim 24, Spies discloses the limitations as discussed in Claim 1 above, Spies further discloses wherein said hardware decryption module comprises a self-contained device which is tamperproof so as to prevent compromise and copying of information stored therein (col. 13, lines 35-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spies as applied to claim 1 above, and further in view of Jones et al. (U.S. Patent 6,697,944 B1) herein referred to as Jones.

Regarding on Claim 21, Spies discloses the limitations as discussed in Claim 1 above, Spies explicitly does not disclose wherein said hardware decryption module functions as a universal serial bus (USB) hub between said host device and said smart token, said hardware decryption module having a plug connectable to said host device and a socket for receiving said smart token.

However, Jones discloses the hardware decryption module functions as a universal serial bus (USB) hub between said host device and said smart token (col. 9, lines 45-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the Jones's invention with Spies to include the USB device with the motivation being to allow for enhancing security.

Prior Art

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Saito et al. (U.S. Patent 6,128,605) discloses a data copyright management apparatus for handling data copyrights and data of digital cash, and for use in video conference systems is provided. The data copyright management apparatus is connected to a user terminal, and is used for performing decryption of encrypted digital data to be copied and edited, and also performing encryption of decrypted digital data to be stored, copied and transferred.

Kravitz et al. (U.S. Patent 6,738,905 B1) discloses a method and apparatus for distributing content data from a content provider to a subscriber. The method includes encrypting content data by the content provider and providing the content data from the content provider to a broadcaster. The provider also provides a content descriptor, including keys to decrypt the encrypted content, to a conditional access provider.

Higurashi et al. (U.S. Patent 6,834,349 B1) discloses the invention provides a recording media player and a recording media recorder provided with a high-security copy protection system of less complexity.

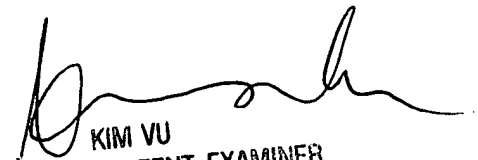
Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Tran N. To whose telephone number is 571-272-8156. The examiner can normally be reached on Monday-Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bao Tran N. To
Patent Examiner
07/18/2005


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